

In re Patent Application of:
Pettis, Rodney L.

Serial No. 10/760,337

REMARKS

As an initial matter, Applicant has added new independent Claim 28 which includes all of the limitations of Claim 15 plus the additional limitations of measurement of shrink in both the transverse and machine directions, as well as ranges for tensile modulus and strength. As discussed in detail below, Claim 15 is in condition for allowance and, therefore, no further examination should be needed in regards to Claim 28. Claims 29 to 35 depend upon new Claim 28, and likewise should be in a condition for allowance without further examination.

In the Final Office Action, the Examiner once again rejected Claims 1-27 under 35 U.S.C. § 103(a) as being obvious, and, therefore, unpatentable, over a single patent document, namely Schirmer et al., U.S. Pat. No. 5,219,666 ("Schirmer") (Final Official Action, Page 2, No. 1, para. 1). Applicant respectfully disagrees.

Final Office Action Status Should Be Removed:

As a formality and as discussed in more detail below regarding the improper assertions of inherency and optimization, Applicant respectfully submits that the "final" status of the present application is improper. First, the Examiner has failed to "provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art," *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original); MPEP 1212 (IV). Second, the Examiner has made assertions that values from the prior art fall into the range of Applicant's claims, but the Examiner has failed to identify the implicated claims with certainty. MPEP § 707.07(i). Therefore, the Applicant is unclear on which claims are allegedly implicated, and has to make assumptions to respond to this Final Office Action. Third, the Examiner improperly and with piecemeal-type hindsight reconstructions the single piece of asserted prior art to determine that one skilled in the art would choose one of several reasonable and logical options over the others based on Applicant's disclosures being used as a road map. MPEP § 707.07(g). Based on these three examples, among others, Applicant respectfully submits that the "final" status of the present application is improper and should be removed.

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Nature of the Problem:

Applicant respectfully submits that the entire misunderstanding between Applicant and the Examiner is colored by the fact that Schirmer's invention and the embodiments of Applicant's invention are directed at different problems in the packaging industry. As the Supreme Court held in *Eibel Process Co.*, the identification of the problem to be solved may be the "essential part" of the new discovery. *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 68 (1923). Additionally, as the CCPA held in *Sponnoble* "a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified," and, therefore, the discovery should be considered part of the "subject matter as a whole." *In re Sponnoble*, 405 F.2d 578, 585 (1969); *see also In Re Peehs*, 612 F.2d 1287, 1290 (CCPA 1980); *In re Kaslow*, 707 F.2d 1366, 1373 (Fed. Cir. 1983).

Applicant submits that Schirmer is directed at replacing polyvinyl chloride (PVC) packaging used "for overwrapping trayed food products" and for labeling on "cans and bottles" (Col. 1, lines 10-51). Applicant's invention is a shrink wrap for packaging products while allowing for the products to be viewed through the packaging. As Applicant's application noted:

A need exists for a packaging film that is economical to produce and can be manufactured on existing equipment, without having to modify the equipment. There also is a continued need for a packaging film that is relatively thin, has good optical properties to allow a product to be seen easily through the packaging film, and has good mechanical properties to allow the packaging film to withstand outward forces being applied to the packaging without puncturing easily.

(Patent Application, para. 07). Thus, for example, while Schirmer is directed towards a label on a bottle, Applicant's packaging film is directed at packaging multiple bottles together while still allowing a consumer to view the product contained within the packaging. Therefore, Applicant's invention is for a multilayer film that has both advantageous optical and mechanical properties for packaging products. The need for these characteristics in Applicant's invention are completely different from the need for related characteristics, that may appear upon casual observation to be similar, in Schirmer's disclosures, teachings, and claimed invention. When the nature of the problem being solved is considered, because two different problems are being solved, clearly there is no motivation to modify or combine Schirmer to produce the invention that Applicant is claiming. *See Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S.

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45, 68 (1923). Furthermore, for the Examiner to continue to so do would be improperly "defining the problem in terms of its solution," which "reveals improper hindsight in the selection of the prior art [by the Examiner] relevant to" the Examiner's obviousness rejection. *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880 (Fed. Cir. 1998).

Claims 1-27 are Nonobvious:

Applicant once again submits that Claims 1-27 are nonobvious over Schirmer, which the Examiner admits does not show all of the elements of the claimed invention, and that the Examiner has not set forth a proper *prima facie* case of obviousness as set forth by both the Federal Circuit and the MPEP. As noted previously and discussed in more detail below, to establish a *prima facie* case of obviousness, three basic criteria must be met. See *In re Vaack*, 979 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP §§ 2142, 2143 – 2143.03.

No Suggestion or Motivation to Modify or Combine:

First, as the Examiner is aware, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. See *In re Vaack*, 979 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) (if an obviousness rejection is based on a single reference, then there must be a suggestion or motivation in the reference to modify the teachings or disclosures of that reference); MPEP § 2143.01. Furthermore, there are three types or sources of motivation to modify or combine: (1) the nature of the problem; (2) the teachings of the prior art; and (3) knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (although the combination of references taught every element of the claimed invention, because there was no motivation to combine, a rejection based on obviousness was held improper); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); MPEP § 2143.01. Although the suggestion or motivation to modify the single reference may flow from the nature of the problem being solved, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), "defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139

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F.3d 877, 880 (Fed. Cir. 1998). Additionally, the motivation or suggestion of the prior art reference may be explicit or implicit from the prior art reference as a whole. *See WMS Gaming, Inc. v. Inter'l Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999); MPEP § 2143.01. Furthermore, the "test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)); MPEP § 2143.01.

Although the "the level of skill in the art is a prism or lens through [to view] the prior art and the claimed invention," the level of skill in the art is merely a "reference point that prevents [the Examiner] from using their own insight or, worse yet, hindsight, to gauge obviousness." *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999). As noted by the Federal Circuit "[r]arely ... will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment." *Id.* (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.")). Furthermore, "[s]kill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case, but instead supplies the primary guarantee of objectivity in the process." *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999) (citing *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991)). Finally, in evaluating "the propriety of the Patent Office case for obviousness ... it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Examiner Improperly Uses Applicant's Application as Motivation to Modify:

With these basic premises set forth by the Federal Circuit and CCPA regarding the suggestion or motivation to modify or combine, and after reviewing the Examiner's Final Office Action, with respect to independent Claims 1, 15 and 27, Applicant believes that the crux of the

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misunderstanding between the Applicant and the Examiner relates to why the five (5) layer and two (2) layer alternate embodiment for a multilayer film of Schirmer do not teach or suggest an embodiment in which an inner layer of polyolefin is positioned between and abuttingly in contact with a first and third outermost layer of elastomer. With only one reference, directed at solving a problem separate and apart from the problem identified and solved by Applicant, and as noted in the Final Office Action, the Examiner has taken the position that:

... Schirmer teaches that the shrink-wrap packaging film comprises a first outermost layer of elastomer, a second inner layer of polyolefin overlying the first outermost layer of elastomer, and a third outermost layer of elastomer overlying the second inner layer of polyolefin wherein both the first and third outermost layers of elastomer are adhered to the second inner layer of polyolefin by means of a polymeric adhesive intermediate layer (column 3, lines 10-20). Schirmer also teaches that the elastomer (styrene butadiene copolymer) layer is directly adhered to the polyolefin (very low density polyethylene) layer, as an alternative to using a polymeric adhesive disposed between the two layers (column 12, lines 34-48).

(Final Office Action, Page 2-3, No. 3, para. 2). Applicant notes, and the Examiner appears to have overlooked, that throughout Schirmer the preferred embodiment that is disclosed and taught relates to a five (5) layer film, a core layer of very low density polyethylene ("VLDPE"), two (2) layers of adhesive, and two (2) outer layers of styrene butadiene copolymer ("SBC") (*see, e.g.*, Col. 2, line 55 to Col. 3, line 35; Col. 4, line 29 to Col. 12, line 25). The alternate two (2) layer embodiment in contrast is only cursorily mentioned twice in Schirmer (*see* Col. 3, lines 36-40; Col. 12, lines 26-31). Furthermore, the second reference to the alternate embodiment in the detailed description denotes that another alternate includes the use of an adhesive layer (Col. 12, lines 27-28). Therefore, because the Schirmer reference reemphasizes the use of adhesive after merely hinting at directly applying a single layer of SBC to a single layer of VLDPE (Col. 12, lines 26-31), one skilled in the art would not readily make a leap of faith without some additional suggestion or motivation from a two (2) layer film without adhesive to an embodiment of a three (3) or more layer film of Applicant's claimed invention without the use of intermediate adhesive layers.

Applicant respectfully reminds the Examiner that the Examiner should not "read obviousness into an invention on the basis of the applicant's own statements," and "must view the

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prior art without reading into that art [Applicant's] teachings." See *In re Sponnoble*, 405 F.2d 578, 585 (1969). Unfortunately, Applicant submits that is exactly what the Examiner has done with this application. Nothing in the brief mention of direct adherence of an SBC to a VLDPE teaches, suggests, or even hints that more than two (2) layers may be directly adhered to each other. Additionally, the reference to using an adhesive once again after mentioning direct adhesion when read in light of the patent as a whole would teach away from the Applicant's invention. See *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). If more than two layers could be directly adhered together successfully, there would be no need for Schirmer to mention the adhesive layer again (Col. 12, lines 27-28). The clear implication by Schirmer reemphasizing the use of an adhesive layer is that the invention disclosed, taught and claimed by Schirmer is more likely to work if an adhesive layer is used rather than the merely theoretical reference to directly adhering two (2) layers together. Similar to *In re Gordon* where the Federal Circuit reversed the Board's determination that turning an invention upside down that uses gravity as a separator for fluids would not have rendered the claimed invention obvious; using three or more layers in a multilayer film without adhesive layers in between the layers would be inconsistent with the disclosures and teachings in Schirmer. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Therefore, reading the patent as a whole and the overall importance placed on the use of adhesive layers, it would not have been readily apparent to one skilled in the art that the invention disclosed, taught and claimed in Schirmer could be modified to a multilayer film with three (3) or more layers not adhered with intermediate adhesive layers unless Applicant's application was used as a road map to the problem identified and solved by Applicant. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); MPEP 2143.01. Thus, the Examiner has improperly "read obviousness into an invention on the basis of [Applicant's] own statements," and the Examiner has rejected Applicant's application over Schirmer only after reading Applicant's teachings into what is disclosed, taught, and claimed by Schirmer. See *In re Sponnoble*, 405 F.2d 578, 585 (1969).

Examiner Improperly Uses Hindsight as Motivation to Modify:

Applicant would also respectfully remind the Examiner that the mere fact that, in hindsight, a reference has the "potential" to be modified or combined does not render the

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modification or combination obvious unless the prior art suggest the desirability of the combination. *See In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); *In re Kotzab*, 55 USPQ2d 1313 (Fed. Cir. 2000); MPEP § 2143.01. In *Mills*, the Federal Circuit held that although the prior art invention could be modified "to run the way the apparatus claimed, there must be a suggestion or motivation in the reference to" make the modification. *Id.* at 682, 1432. Applicant observes that the Examiner appears to be falling into what the Federal Circuit has referred to as the "hindsight trap." In *Kotzab*, the Federal Circuit reversed the Board's findings that the claimed invention using one sensor was obvious in light of the prior art for one system of multiple sensors noting that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found *prior art statements that in the abstract appeared to suggest the claimed limitation*. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.

In re Kotzab, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (*emphasis added*).

Based on the Examiner's misunderstanding of the disclosures, teachings, suggestions and motivations in Schirmer, as discussed above, the Examiner has taken the position that:

although Schirmer fails to disclose any examples wherein both first and third outermost layers of elastomer are directly adhered to the second inner layer of polyolefin instead of through a polymeric adhesive intermediate layer, because Schirmer teaches that an elastomer layer can be directly adhered to a polyolefin layer as an alternative to using a polymeric adhesive intermediate layer between the two layers, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have directly adhered the first and third outermost elastomer layers to the second inner layer of polyolefin, in order to obtain a thinner multilayer film with the same properties provided by the three layers.

(Final Office Action, Page 2-3, No. 3, para. 2). Applicant once again respectfully submits, and reiterates, that the Examiner has failed to meet the first element of a *prima facie* case for obviousness. First, as discussed above, based on both the facts and US patent law there is no suggestion or motivation apart from Applicant's application, either in the reference itself or in the

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knowledge generally available to one of ordinary skill in the art, to modify the reference. Furthermore, the Examiner has the burden of showing such suggestion or motivation, which has not been met here. *See Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985); MPEP §§ 2142, 2144-2144.09.

For example, unlike Claim 1, Schirmer does not describe or suggest a film having "a first outermost layer of elastomer, a second inner layer of polyolefin overlying and abuttingly contacting the first outermost layer of elastomer, and a third outermost layer of elastomer overlying and abuttingly contacting the second inner layer of the polyolefin so that the second inner layer of polyolefin is positioned between the first and the third outermost layers of elastomer." Likewise, Schirmer does not describe or suggest a film having "a first layer of a sheet of elastomer; a second layer of polyolefin having a first surface abuttingly contacting a first surface of the first layer of the sheet of elastomer; and a third layer of a sheet of elastomer abuttingly contacting a second surface of the second layer of polyolefin so that the second layer of polyolefin is positioned between the first and third layers of elastomer" as set forth in Claim 15. Additionally, Schirmer does not describe or suggest a film having "a first layer of a sheet of elastomer, a second layer of polyolefin having a first surface abuttingly contacting a first surface of the first layer of the sheet of elastomer, and a third layer of a sheet of elastomer abuttingly contacting a second surface of the second layer of polyolefin so that the second layer of polyolefin is positioned between the first and third layers of elastomer" as set forth in Claim 27.

Applicant notes once again that Schirmer only describes two general embodiments for a multilayer film. First, Schirmer describes a multilayer film having a core layer of VLDPE; two outer layers each of SBC; and two intermediate layers each of a polymeric adhesive bonding the core layer to a respective outer layer (Col. 2, lines 55-62). In connection with this embodiment, Schirmer further includes Example 1 (Col. 7) and Table 2 (Col. 7 & 8), which together show twenty-three (23) different test results utilizing this described structure. All twenty-three of these test results utilize a polymeric adhesive layer positioned between the core polyethylene layer and each of the outer SBC layers. Second, Schirmer briefly describes an alternative embodiment in which "a *single layer* of VLDPE (polyethylene) may be adhered, either directly or by means of a polymeric adhesive layer, to a *single layer* of styrene butadiene copolymer..." (Col. 12, lines 26-31) (*emphasis added*). Thus, in the only reference cited by the Examiner, there is no suggestion,

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motivation, or teaching of an embodiment in which an inner layer of polyolefin is positioned between, and abuttingly contacts, first and third outermost layers of elastomer.

Schirmer, in fact, teaches away from the second embodiment being modified to form a structure as claimed by Applicant, because according to the teachings, disclosures, suggestions and motivations of Schirmer, Applicant's claimed invention would be unsatisfactory. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Furthermore, Applicant observes that this situation appears to be similar to *In re Ratti* where the CCPA reversed the Board when the prior art taught resiliency and the patentee claimed rigidity. *In re Ratti*, 270 F.2d 810, 123 USPQ 349, 352 (CCPA 1959). Specifically, the Schirmer film is a "thin" polymeric film. (Col. 1, lines 11-13). Schirmer states that the film "exhibits excellent elasticity." (Col. 1, lines 57-58). Schirmer also indicates that during testing, it was discovered that when the thickness of the outermost SBC layers in the experimental structure were downgauged or decreased in thickness, the final film exhibited better elasticity. (Col. 9, lines 42-45). Thus, it would be counterintuitive to one skilled in the art to add additional layers to the embodiment comprising a single layer of VLDPE and a single layer of SBC, as this would increase the total thickness of the SBC layering of the structure, which test results from the Schirmer indicate according to the claimed invention of Schirmer would diminish the elasticity of the film, as well as increase the overall total thickness of the entire structure, thereby adversely affecting the gloss, clarity and other optical properties of the film. Therefore, according to the Federal Circuits holding in *In re Gordon*, it would not have been obvious to one skilled in the art to go against the teachings, disclosures, suggestions and motivation of Schirmer to increase the thickness of a multilayer film to 1 – 3 mils. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Not only is there no suggestion in Schirmer as to the desirability of modifying the reference as claimed by Applicant, but also the modification would, in fact, not be desirable, as it would diminish the advantageous properties of the film disclosed and claimed by Schirmer. *See In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Despite Schirmer teaching away from Applicant's claimed invention, Applicant respectfully submits that the Examiner has ignored Applicant's argument and randomly asserted that:

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Applicant is respectfully reminded that the especially preferred films wherein the thickness of the outer layers (note plural) is downgauged in order to produce a film with better elasticity, contain two outer layers [of elastomer] (column 9, lines 42-60).

(Final Office Action, Page 4, No. 4, para. 2). Applicant notes that the section the Examiner is referring to is describing the preferred five (5) layer embodiment using intermediate adhesive layers, although the Examiner has asserted that the obviousness is based on the two (2) layer alternate embodiment. At the same time, the Examiner merely dismisses the argument based on the assertions of Schirmer that a thicker multilayer film diminishes the elasticity of the film, as well as increasing the overall total thickness of the entire structure, thereby adversely affecting the gloss, clarity and other optical properties of the film. Furthermore, the addition of the adhesive layers in Schirmer arguably affects the total thickness of the film, its elasticity, and optical qualities as supported by Schirmer's test results.

Applicant further observes that the section referred to by the Examiner states that the preferred thickness of Schirmer's five (5) layer film "is less than about 1 mil, and more preferably less than about 0.5 mils" (col. 9, lines 48-51). Nevertheless, both the five (5) layer film and the two (2) layer film of Schirmer are alleged to have a "preferred thickness of about less than 1 mil" (Col. 9, lines 48-50; Col. 12, lines 30-31). In contrast, Applicant's detailed description notes that Applicant's three (3) layer film, which does not use any adhesive intermediate layers, has a preferable thickness in the range of about 0.5 to 3 mils that allows for a more economical film to manufacture "without a reduction in the clarity or strength of the packaging film" (Application, para. 49). With this in mind, Applicant respectfully submits that less than 1 mil for a five (5) layer structure in no way equates to a range of 0.5 to 3 mils for a three (3) layer structure, unless the Examiner engages in improper piecemeal-type hindsight to attempt to reconstruct Schirmer based on "mere speculation" or "possibility" using Applicant's disclosure as a blueprint. *See In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); MPEP § 707.07(g). Furthermore, a less than 1 mil five (5) layer structure with intermediate layers of adhesive also in no way equates to a 0.5 to 3 mil three (3) layer structure, or even a five (5) layer structure, without intermediate adhesive layers, unless the Examiner yet again engages in improper piecemeal-type hindsight to attempt to reconstruct Schirmer based on "mere speculation" or "possibility" using Applicant's disclosure as a blueprint. *See In re*

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Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); MPEP § 707.07(g). Similarly, a less than 1 mil two (2) layer structure in no way equates to a range of 0.5 to 3 mils for a three (3) layer structure, unless the Examiner once again engages in improper piecemeal-type hindsight to attempt to reconstruct Schirmer based on "mere speculation" or "possibility" using Applicant's disclosure as a blueprint. *See In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); MPEP § 707.07(g). In summation, the structures of Schirmer's multilayer film and Applicant's claimed invention are in no way equal unless improper piecemeal-type hindsight is used to attempt to reconstruct Schirmer based on mere speculation or possibility.

Not only has mere speculation and possibility been used to attempt to some how arrive at the claimed invention, but also nothing teaches or suggests in either Schirmer or the Examiner's arguments how this newly created structure derived by the Examiner based on Applicant's disclosure would perform or operate. Would it have an adhesive layer? What is the result, if like Applicant's case, there is no adhesive layer? What would the mechanical properties be? What would the optical properties be? What would the haze factor be? What clarity could be achieved? What tensile strength would be achieved? What tensile modulus would be achieved? Again, nothing in Schirmer's test tables indicate any mechanical qualities that would somehow result in or from Applicant's claimed invention. Similarly, nothing in Schirmer's test tables indicate any percentage of haze, clarity, or gloss that would somehow result in or from Applicant's claimed invention. Therefore, while Schirmer's disclosed, taught, and claimed films are concerned with the elasticity and optical properties of the film, Applicant's invention is directed towards the mechanical strength of the film that also has a low degree of haze, i.e., the inverse of clarity. Additionally, Applicant submits that this once again highlights the difference in the nature of the problems being solved by Schirmer and Applicant.

Based on the facts of this situation, on precedential US patent law, and reasonable conclusion drawn from the facts, Applicant respectfully submits that the Examiner has failed to meet the Examiner's burden for establishing the first factor of a *prima facie* case for an obviousness rejection of Applicant's independent Claims 1, 15 and 27.

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No Reasonable Expectation of Success:

Second, as the Examiner is aware, there must be a reasonable expectation of success. See, e.g., *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989); MPEP § 2143.02. From the discussion above, one skilled in the art would realize that modifying the reference to cover Applicant's claimed invention would increase the thickness of the SBC layer, by the addition of a second SBC layer, and, therefore, the overall thickness of the film, which would result in according to the teachings, disclosures, test, and examples of Schirmer in, among other disadvantageous features, reduced elasticity, and thus produce an inferior product. It would be counterintuitive and illogical for the Examiner to argue that the suggestion of an inferior product would equate with a reasonable expectation of success. Furthermore, this is not a situation similar to *In re Merck & Co., Inc.* where the prior art disclosed related compounds that were "known bioisosteric replacements" and, therefore, should exhibit similar "pharmacological properties." *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In fact, according to the teachings, disclosures, test and examples of Schirmer, Applicant's claimed inventions should be unsuccessful with poor optical quality because the thickness range of Applicant's film generally exceeds the preferred total film thickness disclosed by Schirmer.

Additionally, there must be some degree of predictability to sustain a rejection based on obviousness. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re O'Farrell*, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988); MPEP § 2143.02. Unlike *In re O'Farrell*, Schirmer does not contain an enabling methodology, a suggestion or motivation to modify the prior art to produce Applicant's claimed invention, and evidence suggesting the modification would be successful. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

Based on the facts of this situation, and based on precedential US patent law, Applicant respectfully submits that the Examiner has failed to meet the Examiner's burden for establishing the second factor of a *prima facie* case for an obviousness rejection of Applicant's independent Claims 1, 15 and 27.

Applicant would further note that Schirmer does not contain both (1) a suggestion or motivation to modify the reference and (2) a reasonable expectation of success not based on

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Applicant's disclosure as required by the US patent law. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *see also* MPEP 706.02(J). As such, Applicant respectfully submits the Examiner's rejection again fails to meet the Examiner's burden to establish either alone or in combination the first or second factors of a *prima facie* case for an obviousness rejection of Applicant's independent Claims 1, 15 and 27.

Prior Art Does Not Include All Claim Limitations:

Finally, as the Examiner is aware, the prior art reference must teach or suggest all claim limitations to establish a *prima facie* case for obviousness. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP § 2143.03. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of [a] claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); MPEP § 2143.03. Therefore, if any independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending upon that independent claim is also nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143.03. As described previously herein, Schirmer does not describe or suggest, at least, a film having "a first outermost layer of elastomer, a second inner layer of polyolefin overlying and abuttingly contacting the first outermost layer of elastomer, and a third outermost layer of elastomer overlying and abuttingly contacting the second inner layer of the polyolefin so that the second inner layer of polyolefin is positioned between the first and the third outermost layers of elastomer." Likewise, Schirmer does not describe or suggest, at least, a film having "a first layer of a sheet of elastomer; a second layer of polyolefin having a first surface abuttingly contacting a first surface of the first layer of the sheet of elastomer; and a third layer of a sheet of elastomer abuttingly contacting a second surface of the second layer of polyolefin so that the second layer of polyolefin is positioned between the first and third layers of elastomer." Nor does Schirmer describe or suggest a film having "a first layer of a sheet of elastomer, a second layer of polyolefin having a first surface abuttingly contacting a first surface of the first layer of the sheet of elastomer, and a third layer of a sheet of elastomer abuttingly contacting a second surface of the second layer of polyolefin so that the second layer of polyolefin is positioned between the first and third layers of elastomer."

Therefore, Applicant respectfully submit that the Examiner has not established a *prima facie* case of obviousness because, as a minimum, Examiner has not shown: (i) some suggestion

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or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference; (ii) a reasonable expectation of success; or (iii) a teaching or suggestion of all claim limitations.

Accordingly, Claims 1, 15 and 27 have been shown to be novel, nonobvious, and allowable with respect to the cited art. Correspondingly, dependent Claims 2-14, and 16-26 have likewise been shown to be allowable. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143.03.

Dependent Claims have independent basis for nonobviousness:

Applicant once again submits that dependent Claims 2-14 and 16-26 also have independent novelty and are nonobvious. The Examiner originally objected to each of Claims 7, 9, 11, 12, 14, 22, 23, 24, and 26 based upon the subject matter being "inherent" in the teaching of Schirmer. Furthermore, Claims 9, 11, 12, 14, 22, 23, 24, and 26 were objected to because, according to the Examiner, the subject matter of the claims could be produced by one skilled in the art by optimizing the processing conditions of the packaging film of Schirmer. The Examiner also objected to independent Claim 27 on both of the grounds listed above. Applicant once again respectfully disagrees with these objections.

As noted in Applicant's first Response to Office Action, each of Applicant's claims mentioned in the previous paragraph deals with a specific numerical limitation or range relating to a feature of Applicant's invention. These particular features are not discussed or described in, or suggested by, Schirmer. In particular, Schirmer does not show or suggest: "a haze in a range of about 1 % to about 10%" (Claims 7, 22); a 45° gloss in a range of about 70% to about 110% (Claims 9, 22, 27); a tensile modulus in a range of about 50,000 psi to about 120,000 psi (Claims 11, 23); a tensile strength in a range of about 2000 psi to about 3500 psi (Claims 12, 24); or a dart impact strength in a range of about 300 grams to about 1000 grams (Claims 14, 26). In response to Applicant's arguments, the Examiner now asserts that:

Applicant is respectfully apprised that a chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). *See* MPEP 2112.01. In the instant case, Schirmer teaches that the two outer layers of elastomer are formed from styrene

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butadiene copolymer (column 7, lines 5-10), the same materials claimed by Applicant (original claim 2), and that the inner layer of polyolefin is formed from polyethylene and/or ethylene vinyl acetate which is an ethylene/unsaturated ester copolymer, the same materials described in Applicant's specification (page 11, section 0048). Therefore, the specific numerical values claimed by Applicant are necessarily present or the result of routine optimization by one of ordinary skill in the art at the time the invention was made, in order to enhance the desired properties. Applicant has not provided a showing of unexpected results over the film of Schirmer. Furthermore, Schirmer teaches the presence and desirability of the properties claimed by Applicant, albeit not disclosing the specific numeric values.

(Final Office Action, Page 4-5, No. 5, para. 2). Despite chemical structures having related properties, Applicant respectfully submits that the Examiner has made a crucial flaw in the Examiner's analysis by ignoring the adhesive layers. The Examiner has once again taken the preferred five (5) layer embodiment from Schirmer—which includes two outer layers of elastomer formed from styrene butadiene copolymer (col. 7, lines 5-10), an inner core layer of VLDPE (col. 4, lines 32-34), and two (2) intermediate "polymeric adhesive" layers between the core and outer layers (col. 5, lines 6-19)—and ignored the structure disclosed in Schirmer, namely the two (2) intermediate "polymeric adhesive" layers between the core and outer layers (col. 5, lines 6-19). Therefore, although the two films may have related chemical structures, they are not identical chemical structures as the Examiner asserts for the first time in the Final Office Action.

The Examiner once again asserts that these features are inherent in the reference or can be produced via optimization. Applicant once again notes that the fact a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); MPEP 1212 (IV). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51

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(Fed. Cir. 1999); MPEP 1212 (IV). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original); MPEP 1212 (IV). As discussed briefly above, Applicant respectfully submits that this has not been provided, and at a minimum makes the "final" status of the present application improper.

Once again, Schirmer only makes broad and general representations regarding certain of the advantageous features of its film, such as the film "exhibits excellent elasticity, toughness, stretch and optical properties..." (Col. 1, lines 55-60); the film has "excellent optical properties, specifically excellent gloss and clarity ..." (Col. 2, lines 47-50); and the film is "ultra-clear and glossy..." (Col. 8, line 2). The specific numerical values claimed in embodiments of the present claimed invention are new and surprising results based upon the novel and nonobvious multilayer structure that does not utilize intermediate adhesive layers, and cannot be presumed to be inherent in the nonspecific teachings and representations of Schirmer. Without any teaching or suggestion in Schirmer as to how to achieve these optimal values, Applicants' claimed results, at best, are only probable or possible according to the teachings of Schirmer. *See In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); MPEP 1212 (IV). This is particularly true when the differences in the layer structures of Schirmer and Applicants' claimed invention are taken into account. Furthermore, the Examiner has once again failed to "provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original); MPEP 1212 (IV). The Examiner merely asserts without any factual support that the ranges disclosed by the Applicant are the same ranges as disclosed and taught in Schirmer, despite none of the properties or ranges appearing anywhere in Schirmer. Furthermore, the Examiner does not provide any other reference that would support or even help to bolster the Examiner's assertions. The Examiner does not reference the prior art cited in Schirmer for support of the Examiner's assertions. All in all the Examiner merely takes a conclusory position that optimization would result in Applicant's claimed ranges, without providing any logical basis, tie, support, or even hint that Schirmer discloses, teaches, or even suggests the ranges claimed by

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Applicant. As a result, Applicant submits that the features of Claims 7, 9, 11, 12, 14, 22, 23, 24, 26 and 27 are not inherent in Schirmer, because at a minimum the examiner has failed "provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original); MPEP 1212 (IV).

Applicant believes that the Examiner has once again objected to Claims 6 and 21 because Schirmer's values allegedly fall within Applicants' claimed ranges. Applicant is, however, uncertain as to the objection because the Examiner has failed to mention Claims 6 and 21 in the Final Office Action. MPEP § 707.07(i). Assuming that the Examiner was referring to Claims 6 and 21, Applicant notes that the Examiner has once again based the calculations on the assumption that if the adhesive layers were removed, to maintain the desired characteristics of the film, each of the outer SBC layers would remain the same size, and the size of the middle polyethylene layer would increase. Once again, Applicant notes that there is no teaching or suggestion, however, that this would occur. Therefore, it is possible that if the adhesive layers were removed, for example, the middle polyethylene layer would remain the same size (42%), and the two outer layers would increase in size ($58\% / 2 = 29\%$ each). This possibility would bring the sizes of the layers outside of Applicants' claimed ranges. The Examiner has noted that Schirmer's Example 1 has a thickness of 13%, which is within Applicant's claimed range of about 10 to about 25 percent. Applicant would note, however, that claim 4 of Schirmer also states that the SBC layers are "about 8% of the total film thickness" (Col. 12, lines 48-49). Based on Schirmer claim 4, it is possible that if the adhesive layers were removed, for example, the middle polyethylene layer would increase to a size of about $(100 - (2 \times 8)) = 84\%$. This possibility would once again bring the sizes of the layers outside of Applicants' claimed ranges, first and third elastomer layers of about 10% to about 25%, and the polyolefin layer of about 50% to about 80%. Therefore, when Schirmer is read as a whole there is no teaching or suggestion in Schirmer that one or the other of these modifications options is what would occur or even be preferred. Furthermore, the Examiner should not use improper and piecemeal-type hindsight reconstruction to determine that one skilled in the art would choose one possible option

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over the other. MPEP § 707.07(g). Thus, it is once again respectfully submitted that the Examiner's objection to Claims 6 and 21 is improper. *See* MPEP §§ 707.07(g) and (i).

Therefore, Applicant respectfully submits that based on the foregoing remarks, Claim 1-27 are novel, nonobvious and patentable in view of Schirmer.

In commenting upon the Examiner's objections herein in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the Examiner's arguments and the present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed distinctions to create any implied limitation in the claims. Not all of the distinctions between the Examiner's objections and Applicants' present invention have been made by Applicants. For the foregoing reasons, Applicants reserve the right to submit additional evidence showing the distinctions between Applicants' invention to be novel, unobvious, and patentable over the prior art of Examiner's objections, including without exception those in the most recent office action and previous office actions.

The foregoing remarks are intended to assist the Examiner in re-examining the application and in the course of explanation may employ shortened or more specific variants descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered to be exhaustive of the facts of the invention, which render it patentable, being only examples of certain advantageous features and differences that Applicants' attorney chooses to mention at this time.

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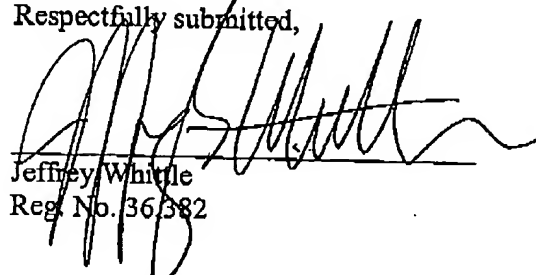
CONCLUSION

In view of the amendments and remarks without prejudice set forth herein, Applicant respectfully submits that the application is in condition for allowance. Accordingly, the issuance of a Notice of Allowance in due course is respectfully requested.

Date: 10/3/05

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Respectfully submitted,


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